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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,437	11/16/2000	Lynn Watson	5087-21	5708
20575	7590	11/18/2004	EXAMINER	
MARGER JOHNSON & MCCOLLOM PC 1030 SW MORRISON STREET PORTLAND, OR 97205			HOGAN, MARY C	
			ART UNIT	PAPER NUMBER
			2123	
DATE MAILED: 11/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,437

Applicant(s)

WATSON ET AL.

Examiner

Mary C Hogan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11/16/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)*
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been examined.
2. **Claims 1-20** have been examined and rejected.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. **Claims 1-20** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification and figures only give a general explanation of how the invention works, but fails to give details as to how the invention is actually made.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. **Claims 9 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. **Claims 9 and 10** recite the term "several". This term makes it unclear as to how many different operating systems and processors. This renders the claim vague and indefinite.

Claim Interpretation

8. **Claims 15-19** refer to "task managing applications". From the claim language and the specification, it was unclear as to what these "task managing applications" refer to. It was concluded,

from reading the prior art of reference, that the task managing applications referred to in the claims refer to the services, or “tasks” provided by or performed by the host.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-8, 10-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Lew et al (U.S. Patent 6,385,567) herein referred to as **Lew**.

11. As to **Claim 1**, **Lew** teaches:

a. a memory operable to store instructions, wherein the instructions include at least one set of instructions for an emulated operating environment (**column 3, line 66-column 4, line 1, column 4, lines 18-26, 33-36**) wherein the memory is either the memory on the host computer or the remote storage device;

b. a connector operable to connect the memory to a host computer (**column 2, line 63-column 3, line 1, column 3, lines 46-48, “logical connections” and column 3, line 59-column 4, line 6**);

c. a processor to: run an original operating system for the host computer; (**column 4, lines 11-15**) and execute the set of instructions to create the emulated environment (**column 4, lines 18-22**).

12. As to **Claim 2**, **Lew** teaches a Universal Serial Bus as an input to the host computer (**column 3, line 41**). Therefore, a Universal Serial Bus Cable is used as a connector between the host device and the memory.

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13. As to **Claim 3**, **Lew** teaches that input devices are often connected to the processor of the host computer by a serial port interface (**column 3, lines 36-38**). The serial port interface encompasses the use of an IEEE-1394 cable since it is a serial bus used for data transfer.
14. As to **Claim 4 and 6**, **Lew** teaches that wireless signals can be used to connect the host computer and the memory (**column 4, lines 4-5**). The use of wireless signals with a network adapter and/or modem encompasses the use of an infrared or a wireless link in accordance with 802.11b.
15. As to **Claim 5**, **Lew** teaches the connection of the host computer and memory as a LAN or WAN (**column 3 lines 54-65**) networking environment using a modem or "other means for establishing communications over a network". It is well known in the art that Ethernet cables are used for network connections between computers in a LAN or WAN environment.
16. As to **Claim 7**, **Lew** teaches the host computer is personal computer compatible (**column 2, line 45**).
17. As to **Claim 8**, **Lew** teaches the host computer is Macintosh compatible (**column 2, line 45**). It is concluded that the statement "other environments are possible" includes the possibility that the host computer can be Macintosh compatible.
18. As to **Claim 10**, **Lew** teaches the at least one set of instructions in memory further comprises multiple sets of instructions for several different processors (**column 4, lines 48-52**) wherein the instructions are the modules for several different processors, for example, native, 80386 or 80486 processors.
19. As to **Claim 11**, **Lew** teaches:
connecting an emulation system having a memory device to a host computer having an original operating system (**column 4, lines 18-26**) wherein the emulation program, 211, may find physical form an indicia recorded on a storage medium (memory) such as the hard drive, diskette or optical disk, which are connected to the memory of the host computer by the system bus (**Figure 1, elements 23,32-34**);
using the original operating system to load a set of instructions from the memory device to the host computer (**column 4, lines 27-31**);
executing the set of instructions to establish an emulated operating environment on the host computer (**column 4, lines 57-59**).
20. As to **Claim 12**, **Lew** teaches user input designating the set of instructions to be loaded from the memory device (**column 3, lines 32-34**). It is concluded that the user input can choose an application to

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be run from the remote storage device, designating the set of instructions to be loaded from memory based on the application chosen.

21. As to **Claim 13**, **Lew** teaches selecting a set of instructions automatically wherein the set of instructions is made by the host computer (**column 4, lines 31-36**). It is concluded that when the host computer determines the operating environment to be simulated, it automatically loads the external modules necessary for execution.

22. As to **Claim 14**, **Lew** teaches wherein connecting the emulation system to the host computer further comprises connecting the emulation system to an accessory device (**column 3, line 46-column 4, line 6**) wherein the emulation system resides on the host computer and the host computer is connected to an accessory device, therefore, the emulation system is connected to the accessory device.

23. As to **Claim 20**, **Lew** teaches:

connecting an emulation system having a memory device to a host computer having an original operating system (**column 4, lines 18-26**) wherein the emulation program, 211, may find physical form an indicia recorded on a storage medium (memory) such as the hard drive, diskette or optical disk, which are connected to the memory of the host computer by the system bus (**Figure 1, elements 23,32-34**);

using the original operating system to load a set of instructions from the memory device to the host computer (**column 4, lines 27-31**);

executing the set of instructions under the original operating system (**column 4, lines 57-59**) to establish the memory device of the emulation system as an external memory device for the host computer (**column 3, line 65-column 4, line 1**).

24. **Claims 15-19** are rejected under 35 U.S.C. 102(e) as being anticipated by Gaines (U.S. Patent 5,961,582) herein referred to as **Gaines**.

25. As to **Claim 15**, **Gaines** teaches: a method of insulating an operating environment emulator from a host computer, the method comprising:

a) blocking host task managing applications for an original operating system on the host computer (**column 6, lines 47-55, column 9, lines 64-67**) wherein the host refuses to perform the service;

b) routing all inputs through the emulated operating system (**column 7, lines 1-4, column 8, lines 43-48, column 9, lines 64-67**); and

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e) activating an environmental shutdown if necessary to prevent interactions between the original operating system and the emulated operating system (**column 7, lines 8-14**) wherein the host refuses to perform the task requested by the emulated operating system.

26. As to **Claim 16**, **Gaines** teaches: wherein blocking host task managing applications further comprises a complete block (**column 7, lines 8-14**) wherein the user's request is denied if it violates access permissions and the host system does not perform the service.

27. As to **Claim 17**, **Gaines** teaches: wherein blocking task managing applications further comprises a partial block (**column 7, lines 4-8**) wherein the user's request is implemented only if it does not violate the access permissions, therefore, some of the requests from the emulated operating system are performed.

28. As to **Claim 18**, **Gaines** teaches: wherein the interactions further comprise any interaction (**column 7, lines 1-14**) wherein any interaction is the "request for service".

29. As to **Claim 19**, **Gaines** teaches: wherein the interactions further comprise interactions selected by a user (**column 8, lines 43-48**).

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

32. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lew** as applied to Claim 1 above, and further in view of **Gaines**.

33. As to **Claim 9**, **Lew** teaches: at least one set of instructions for an emulated operating environment stored in memory (**column 3, line 66-column 4, line 1, column 4, lines 18-26, 33-36**).

34. **Lew** does not expressly teach the at least one set of instructions in the memory further comprises multiple sets of instructions for several different operating systems.

35. **Gaines** teaches at least one set of instructions in the memory further comprises multiple sets of instructions for several different operating systems (**column 5, lines 4-18, 48-50**) wherein the different operating systems are the host virtual operating system and the host operating system. Furthermore, the host virtual operating system can be programmed to include instructions for a plurality of operating systems.

36. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the set of instructions in memory as taught in **Lew** to include instructions for different operating systems as taught by **Gaines** (**column 5, lines 4-18, 48-50**) since both **Lew** and **Gaines** are directed to emulating an operating environment on a host or native operating system.

Response to Arguments

37. Applicant arguments files on 9/14/04 have been considered but are not persuasive.

38. Applicant argues that the specification provides adequate enablement to support the claims. While the specification does discuss the physical components of the system, the specification does not adequately describe the steps necessary to enable the invention, for example, how the instructions for the emulated operating environment are executed and how the task management functions are executed.

39. Applicant argues, "The emulated system, as amended in Claim 1, had a processor to run an original operating system and execute the set of instructions to create the emulated environment. In **Lew**, the multiple platform modules run an application, they do not create the emulated environment", (page 11, paragraph 4).

40. As to the above argument, it is noted that, as per Claim 1, **Lew** teaches a processor to run an original operating system and execute a set of instructions to create an emulated environment (See paragraph 11 above). The X86 platform modules are executed using the emulator, thereby, creating an emulated environment.

41. Applicant argues, "...the emulation system must be connected to the host computer, This is not shown, taught or suggested by **Lew**" (page 11, paragraph 5).

42. As to the above argument, Lew teaches that the emulation system is connected to the host computer (Figure 2, element 211). The emulator is connected to the host system, enabling it to translate the code from the X86 platform to code for the native platform.

43. Applicant argues, "Lew does not teach a connector that connects an emulated system with an emulated operating system to a host computer" (page 12, paragraph 3).

44. As to the above argument, Claims 2-6 refer to "the connector", wherein Claim 1 states "a connector, operable to connect the memory to a host computer". Therefore, there is nothing in the claim language that implies that the connector connects the emulation system to the host computer. The claims read as if a memory is connected to a host computer.

45. Applicant argues, "Lew mentions that the host computer may be compatible with multiple operating systems and platforms, but not that the emulation system is of a different operating system than the host computer" (page 12, paragraph 4).

46. As to the above argument, Claims 7-10 give no indication that the emulated operating system is a different operating system than the host computer.

47. Applicant argues, "Lew may teach that the user input designating a set of instruction may be directed to an application, but not to the creation of the emulation environment. This is not the same as the user selecting the environment to be emulated, the system making the selection automatically, as in claims 12 and 13" (page 12, paragraph 5).

48. As to the above argument, claims 12 and 13 are directed to designating the set of instructions loaded from memory, there is no indication in the claim language that the user is *selecting the environment* to be emulated and that the system makes this selection automatically.

49. Applicant argues, "The emulation system being connected to an accessory device is not shown by Lew" (page 12, paragraph 5).

50. Lew teaches the emulation system is connected to an accessory device (column 3, line 46-column 4, line 6) wherein the emulation system resides on the host computer and the host computer is connected to an accessory device, therefore, the emulation system is connected to the accessory device.

51. Applicant argues that Lew does not insulate the two operating systems (page 13, paragraph 1).

52. As to the above argument, Lew teaches that a module will fail to execute it is not compatible with the native platform and the system will fail to load the application if that is the case (column 6, lines 36-42). While this may imply that the operating system is insulated from an incompatible module that will be emulated by another operating system, Lew does not expressly teach the operating systems are insulated

from one another. However, an updated search has revealed Gaines, which discloses the amended teachings in claims 15-19.

Conclusion


53. The prior art made of record, see PTO-892, and not relied upon, is considered pertinent to applicant's disclosure. Careful consideration must be given prior to Applicant's response to this Office Action.

54. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

55. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary C. Hogan whose telephone number is 571-272-3712. The examiner can normally be reached on 7:30AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 571-272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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